

GREENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
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Reston, VA 20191
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Attorney Docket No. P17856

In re application of : Motoo ASAI et al.

Serial No. : 09/319,258

Filed : December 18, 1997

For : PRINTED WIRING BOARD AND METHOD FOR MANUFACTURING THE SAME

Box Non-Fee

Group Art Unit : 2841

Examiner : J. Alcala

THE COMMISSIONER OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

Sir:

Transmitted herewith is an Election with Traverse in the above-captioned application.

- ___ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously filed.
 ___ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
 ___ An Information Disclosure Statement, PTO Form 1449, and references cited.
X No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 43	*43	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 8	**8	0	x 40=	\$	x 80=	\$0.00
Multiple Dependent Claims Presented			+135=	\$	+270=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

___ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

N/A A Check in the amount of \$_____ to cover the filing/extension fee is included.X The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.X Any additional filing fees required under 37 C.F.R. 1.16.X Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136)(a)(3).

Steven J. Helmer
Reg. No. 40,475
 Bruce H. Bernstein
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Motoo ASAI et al.

Appln No : 09/319,258

I.A. Filed : December 18, 1997

For : PRINTED WIRING BOARD AND METHOD FOR MANUFACTURING
THE SAME



Group Art Unit: 2841

Examiner: J. ALCALA

ELECTION WITH TRAVERSE

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In response to the Restriction Requirement mailed January 17, 2001, Applicants elect the invention of Group II (claims 1-5, 9, 10, 13-26, and 28-43), with traverse.

Applicants submit that a Restriction Requirement is inappropriate in this case.

Importantly, since this application is the national stage of a PCT application filed under 35 U.S.C. § 371, unity of invention rules apply.

The current restriction requirement is improperly based on restriction practice for applications filed under 35 U.S.C. § 111, as opposed to the restriction practice for applications filed under 35 U.S.C. § 371. In explaining the restriction, the Examiner cites M.P.E.P. § 806.05(f) which sets forth the standard for restricting between process of making and product made claims in cases

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filed under 35 U.S.C. § 111. As mentioned previously, the present case was filed under 35 U.S.C. § 371 and not 35 U.S.C. § 111 and, therefore, the restriction is based on an incorrect standard.

M.P.E.P. § 1850 provides that when the PTO considers international applications during the national stage under 35 U.S.C. § 371, PCT Rules 13.1 and 13.2 will be followed when considering the unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. § 111. According to PCT Rule 13.2, unity of invention exists when there is a technical relationship among the claimed inventions involving one or more technical features. Specifically, M.P.E.P. § 1850 states that PCT Rule 13 shall be construed as permitting inclusion in the same application of "an independent claim for a given product" with "an independent claim specially adapted for the manufacture of the said product . . . "

In the present case, the claims of Group II are directed to a printed circuit board and the claims of Group I are directed to a method for producing a printed circuit board, which circuit board may be in accordance with the claims of Group II. Since the present restriction requirement involves restricting between claims for a given product and method claims for the manufacture of a product which, for examination purposes, may be consistent with the given product, the claims should be examined in the same application, according to M.P.E.P. § 1850. Thus, the restriction requirement should be withdrawn.

Furthermore, M.P.E.P. § 1893.03(d) specifically states that "when making a lack of unity of invention requirement, the Examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group."

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The Restriction Requirement fails to explain why each Group lacks unity of invention and, therefore, does not comply with M.P.E.P. § 1893.03(d) and PCT Rules 13.1 and 13.2. For these reasons, the Requirement for Election of Species is improper and should be withdrawn.

Therefore, Applicants respectfully request that the Restriction Requirement be reconsidered and withdrawn. However, if the Restriction Requirement is maintained, Applicants respectfully request that the Examiner set forth reasoning for the Restriction Requirement.

If the Examiner has any questions concerning this matter or the application, the undersigned can be contacted at the below-listed telephone number

Respectfully submitted,
Motoo ASAI et al.

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February 20, 2001
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